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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/027,777	02/23/98	IMMER	H P1614-8019

HM12/0824
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EXAMINER

VANDER VEGT, F

ART UNIT	PAPER NUMBER
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1644

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DATE MAILED:

08/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/027,777

Applicant(s)

Immer et al

Examiner
F. Pierre VanderVegt

Group Art Unit
1644



☒ Responsive to communication(s) filed on Apr 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days, whichever is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 21-33 is/are pending in the application.

Of the above, claim(s) 21-27 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 28-33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1 1/2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

This application is a divisional of application S.N. 08/737,927 which is a rule 371 continuation of PCT/EP95/02050.

Claims 21-33 are currently pending in this application.

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Election/Restriction

1. Applicant's election without traverse of Group II, claims 28-33, in Paper No. is acknowledged.

2. Claims 21-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as
10 being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 18.

Claim Rejections - 35 USC § 102

15 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for a patent.

20 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 28-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 4,751,284 to Forssmann (A on form PTO-892).

25 The '284 patent teaches cardiodilatin and fragments thereof. Specifically, claim 1 of the '284 patent is drawn to full length cardiodilatin and claim 2 is drawn to biologically active fragments thereof. More specifically, claim 28 of the '284 patent is drawn to a cardiodilatin fragment which is the same as the ANP(99-126) peptide instantly disclosed and specifically claimed [instant claim 31]. Therefore, claim 28 of the '284 patent specifically teaches the

cardiodilatin fragments of the instantly claimed invention where R¹ is 99-104 [instant claim 29], R² is 122-126 [30] which are fragments of 90-104 and 122-126 [28], respectively, wherein said fragments are attached to a core which is the same as SEQ ID NO:1. Applicant is reminded that the recitation of "having" in claim 33 is considered open terminology and therefore includes longer amino acid sequences which "have" the recited sequence contained therein. The prior art teaching clearly anticipates the claimed invention.

4. Claims 28-33 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent No. 5,449,751 to Forssmann et al (AA on form PTO-1449).

The '751 patent teaches the cardiodilatin fragment R¹-ANP(105-121)-R² wherein R¹ is ANP(95-104) [instant claim 29] and R² is ANP(122-126) (Abstract and claim 1 of the '751 patent in particular). The '751 patent additionally teaches the fragments of amino acids 99-126 (column 1, line 6 in particular) and 95-125 (column 9, line 36 in particular) as well as pharmaceutical compositions (medicaments; column 3, lines 37-61 in particular). Applicant is reminded that the recitation of "having" in claim 33 is considered open terminology and therefore includes longer amino acid sequences which "have" the recited sequence contained therein. The prior art teaching clearly anticipates the claimed invention.

5. Claims 28-33 are rejected under 35 U.S.C. 102(f) because the Applicant did not invent the claimed subject matter.

U.S. Patent No. 4,751,284 (A) has been discussed supra. The '284 patent discloses that the instantly claimed subject matter was invented in its entirety by Wolf-Georg Forssmann (see entire document). Therefore, Hansueli Immer, Knut Adermann and Christian Klessen are not inventors of the instantly claimed invention.

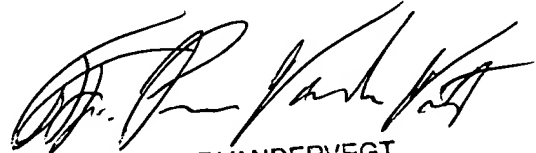
Conclusion

6. Papers related to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center

located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for official documents to be entered into the record for Art Unit 1644 is (703)305-3014.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to F. Pierre VanderVegt, whose telephone number is (703)305-6997. The Examiner can normally be reached Tuesday through Friday and odd-numbered Mondays (on year 2000 366-day calender) from 6:30 am to 4:00 pm ET. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ms. Christina Chan can be reached at (703)308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist, whose telephone number is (703)308-0196.

F. Pierre VanderVegt, Ph.D.
Patent Examiner
Technology Center 1600
July 10, 2000



F. PIERRE VANDERVEGT
PATENT EXAMINER